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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,351

Applicant(s)

BUNTE, UWE

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 22, 2003 have been disapproved. Proposed changes to Fig. 4 do not appear appropriate. Figures 1-3 show separate layers of the retaining device and shaped element. Brief description of Fig. 4 already explains what Fig. 4 depicts. As for the proposed changes to Fig. 4, the proposed changes do not appear to reflect changes to original Fig. 4. Applicant is reminded that the previously proposed drawing changes have not been approved. Piecemeal changes to the drawing figures will not be accepted. Such changes would only serve to confuse the record. Also, it is not apparent as to what numeral 12 depicts with respect to the proposed drawing change. What, for example would the brace, (to which reference numeral 12 is directed), represent?

The proposed drawing changes to Fig. 4, as presented on September 22, 2003 would appear to be appropriate with respect to all reference numerals except 12. A proposed Fig. 4 showing changes to the original drawing may be approved upon submission in response to the instant Office action. As for the cross section lines in Figs. 1, 2, and 3, such would be approved if accompanied by a concise explanation that what is shown in Fig. 4 is a cross section along line IV-IV of Figs. 1-3 with the first half shell of Fig. 1, expansible shaped element of Fig. 2, and second half shell of Fig. 3 in an assembled configuration.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference

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numeral 15. *A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.*

Applicant is reminded that the proposed drawing corrections of August 13, 2001; February 05, 2002; and March 26, 2003 have not been approved.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "said heat-expansible element... retained around said inner contour" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear clear and complete as to "said latching device comprising a latching opening and a corresponding latching rib". The

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specification does not describe any features of the so called "latching opening" or "latching rib". The specification appears to define only the "latching cylinders" and corresponding "mushroom-shaped latching elements" as serving to hold, or latch, the two halves of the "retaining device". The specification is not, at all, clear as to how either or both of the "latching opening" or the "latching rib" serve to hold, or latch, the two halves of the "retaining device".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5, 7, 19, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear as to how the "latching device" is integrally formed on the surface of one of said half shells for connection to an inner wall of a cavity as is now recited in each of claims 7 and 21. The specification and claims, otherwise, appear to define the "latching device" as formed of both the latching cylinder 3 and mushroom-shaped latching element 11 along the inner surfaces of both half-shells. Further, the specification is not clear as to a "latching device" being formed of "a latching opening and a corresponding latching rib" as is now recited in each of claims 5 and 19.

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Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 1, 2, 4, 7-10, 15, 16, 18, and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Miura et al. Miura et al. shows, Fig. 4, retaining device formed by two half-shells 12/14 and 16/11 "latched to one another" via a "latching device" along inner surfaces thereof, col. 2, line 38 and col. 3, line 16, with an expansible shaped element 15, (or 5 as shown in Fig. 2B), of a contoured ring-like plate inserted within the retaining device and disposed around an inner contour of the device. The expansible element expanding under the influence of heat, col. 3, lines 12-14. A "further material free space" is established in areas of the latching device, or where half-shell 12/14 latches to half-shell 16/11.

10. Claims 1-4, 6-10, 15-18, and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hull et al. Hull et al. shows, Fig. 2 and 7 for example, retaining device formed by two half-shells 20 and 16 with an expansible shaped element, (seen along either side of latching

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means 18 of Fig. 2), of a contoured ring-like plate inserted within the retaining device and disposed around an inner contour, (shown by 22 for example), of the device. Latching devices 40/48 and 18 are disposed on inner surfaces of the half shells with element 18 possessing a mushroom-shape at 38. Latching cylinder being at 40/48. A "further material free space" in the area of the latching device is shown by Fig. 2.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4, 6-10, 15-18, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al. in view of any of Steward et al. or Tusim et al. or Doerer or Wycech.

Each of Steward et al., Tusim et al., Doerer, and Wycech teach utilization of synthetic plastic material which material is or has been expanded under the application of heat, 14 of Steward et al., col. 1, lines 38-46 of Tusim et al., col. 1, line 61 to col. 2, line 8 of Doerer, and 44 of Wycech. To have formed the expansible shaped element of Hull et al. of a synthetic plastic which takes form under application of heat, thus utilizing any one of well known synthetic plastic

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foam materials as the filler element, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by any of Steward et al. or Tusim et al. or Doerer or Wycech.

Response to Arguments

Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive. With regard to Applicant's arguments against Miura et al., the expansible shaped element 15 of Miura et al. is the same as the expansible shaped element 5 of Fig. 2. One having ordinary skill in the art to which Miura et al. pertains would immediately realize from the Miura et al. passages at col. 2, lines 53-55, col. 3, lines 13-14, col. 3, lines 60-62, and col. 4, lines 31-32 that the core 5 of Fig. 2 and 15 of Fig. 4 are one and the same encompassing a "heat-expansible material". As for Hull et al., it is not clear as to what Applicant is arguing with by "the latching means 18 is not surrounded by a heat expansible shaped element, but by empty space". As well, it is not clear as to what Applicant is arguing by "appears already expanded, and therefor, cannot be equated with a heat-expansible element, i.e. with a material that is able to expand and will expand under heat". Is Applicant claiming an intermediate product or a final product? At any rate, "heat-expansible material" would serve to define a material in an expanded state as well as an unexpanded state, (if this is what Applicant means by "a material that is able to expand and will expand under heat"). And, the foamed material of Hull et al. would serve to read upon "a heat-expansible" material. Applicant's arguments at the bottom of page 17 to the top of page 18

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of the response are not understood. At least, it is not understood how Applicant's remarks within this paragraph serves to establish patentability. What, for example, would be the "hollow-body wall" recited at lines 22-23 of page 17?

13. Claims 5 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. An amendment to the specification providing a clear description of the interaction between and the purpose of the "latching opening 4" and "latching web 10" would serve to overcome the rejections of claims 5 and 19 under 35 U.S.C. 112.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
December 10, 2003